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10/777,871	02/12/2004	Shaibal Roy	ID-494 (80215)	6107
27975 7590 12/13/2007 ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST P.A. 1401 CITRUS CENTER 255 SOUTH ORANGE AVENUE P.O. BOX 3791 ORLANDO, FL 32802-3791				
EXAMINER BHATIA, AJAY M				
ART UNIT 2145		PAPER NUMBER		
NOTIFICATION DATE 12/13/2007		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

creganoa@addmg.com

Office Action Summary**Application No.**

10/777,871

Applicant(s)

ROY, SHAIBAL

Examiner

AJAY BHATIA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Response to Arguments

Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection. Applicant has filed an RCE 10/22/07.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. "A computer readable medium on a tangible embodiment" is not supported by the specification. The office previously suggested amendment to tangible medium, but since this terminology is not supported by the specification it causes a 112 rejection. Therefore if applicant has not defined a computer readable medium to include "signals" or "carrier wave" or similar not statutory medium, the generic term of "computer readable medium" is acceptable.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/77/577. Although the conflicting claims are not identical, they are not patentably distinct from each other because applicants method of polling for new emails is well known within the prior art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 1 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/778,613. Although the conflicting claims are not identical, they are not patentably distinct from each other because both invention are directed to the same method of polling email server for specific users.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 1 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/678,088. Although the conflicting claims are not identical, they are not patentably distinct from each other because both invention are directed to polling for emails based upon UID.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 and 9-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Horstmann et al (US Patent 6,779,022).

For claim 1, Horstmann teaches, a communications system comprising:

a plurality of mobile wireless communications devices each comprising a respective software client using at least one of a plurality of different operating protocols as configuration commands and instructions for accessing electronic mail and data systems to send at least one access request; (Horstmann, Col. 2 line 61 to Col. 3 line 6, Internet, WAP, modem, Col. 3 lines 39-45, SMTP, IMAP, POP3)

a plurality of data storage devices for storing data files, each data file being associated with a respective mobile wireless communications device, each data file having a unique identification (UID) associated therewith, and each data storage device using at least one of the plurality of different operating protocols; (Horstmann, Col. 7 lines 14-27, UID)

and a protocol interface device comprising a protocol converter module for communicating with said plurality of mobile wireless communications devices using respective operating protocols thereof, and a protocol engine module for communicating with said plurality of data storage devices using respective operating protocols thereof, said protocol engine module also for initiating polling of said data storage devices for UIDs of data files stored thereon, and for cooperating with said protocol converter module to provide UIDs for respective data files to said mobile wireless communications devices upon receiving access requests therefrom, wherein said polling without device initiated commands from said software clients whether there is or is not communication with a mobile wireless communication device to maintain UID's current to within a

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polling interval and reducing latency when communication occurs. (Horstmann, Col. 6 lines 24-30, "regardless of whether the user is currently logged on")

For claim 2, Horstmann teaches, the communications system of claim 1 wherein said protocol engine module detects new data files stored on said data storage devices based upon UIDs thereof, and wherein said protocol engine module cooperates with said protocol converter module to send alert notifications to respective mobile wireless communications devices upon detecting new data files therefor. (Horstmann, Col. 4 lines 6-19, urgent message)

For claim 3, Horstmann teaches, the communications system of claim 1 wherein said protocol interface device further comprises a memory coupled to said protocol engine module for storing the UIDs. (Horstmann, Col. 7 lines 29-39, database)

For claim 4, Horstmann teaches, the communications system of claim 1 wherein said protocol engine module polls said data storage devices only for UIDs. (Horstmann, Col. 7 lines 13-27, UID listed)

For claim 5, Horstmann teaches, the communications system of claim 1 wherein said protocol engine module polls said data storage devices based upon a static polling interval. (Horstmann, Col. 6 lines 23-32, every two minutes)

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For claim 6, Horstmann teaches, the communications system of claim 1 wherein said protocol engine module polls said data storage devices based upon an adaptive polling interval. (Horstmann, Col. 6 lines 23-32, adaptive to user request)

For claim 7, Horstmann teaches, the communications device of claim 1 wherein said protocol converter module and said protocol engine module communicate using a common interface protocol able to represent a desired number of protocol-supported elements for a desired operating protocol. (Horstmann, Col. 6 lines 60-67, engine java)

For claim 9, Horstmann teaches, the communications system of claim 1 wherein said plurality of data storage devices, said plurality of wireless mobile communications devices, and said protocol interface device process electronic mail (e-mail) messages. (Horstmann, Col. 2 line 61 to Col. 3 line 6, internet, Col. 7 lines 25-36, email)

For claim 10, Horstmann teaches, the communications system of claim 1 further comprising a wide area network (WAN) connecting at least one of said wireless mobile communications devices with said protocol interface device. (Horstmann, Col. 2 line 61 to Col. 3 line 6, cell transceiver, internet)

For claim 11, Horstmann teaches, the communications system of claim 1 further comprising a wide area network (WAN) connecting at least one of said data storage

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devices with said protocol interface device. (Horstmann, Col. 2 line 61 to Col. 3 line 6, internet)

Claims 12-33 list all the same elements of claims 1-7 and 9-11. Therefore, the supporting rationale of the rejection to claims 1-7 and 9-11, applies equally as well to claims 12-33.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horstmann in view of Hopmann et al. (US Patent 6,578,069).

For claim 8, Horstmann fails to clearly disclose, the communications system of claim 7 wherein the common interface protocol is based upon a Web-based distributed authoring and versioning (WebDAV) protocol.

Hopmann teaches, the communications system of claim 7 wherein the common interface protocol is based upon a Web-based distributed authoring and versioning (WebDAV) protocol. (Hopmann, Col. 10 lines 25-37, webdav)

Hopmann and Horstmann are both in field of invention storing documents in database system for retrieval

Horstman and Hopmann both utilize UID to track document making both systems compatible

It would be obvious to one of ordinary skill in the art at the time of the invention to combine with Hopmann because Hopmann provided the added benefit of being able to track changes when disconnected from the network. (Hopmann, Col. 2 lines 18-22)

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached Notice of references cited (if appropriate).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay M. Bhatia whose telephone number is (571)-272-3906. Also any interview requests should be faxed directly to the examiner at (571)-273-3906. The examiner can normally be reached on M-F 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571)272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason D Cardone/
Supervisory Patent Examiner,
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